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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,661	12/30/2003	Vivian Agura	03292.101750.	1660
5514	7590	10/01/2008	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				BERMAN, BRIAN J
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/707,661	AGURA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	BRIAN BERMAN	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 July 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### *Response to Amendment*

1. This Office Action is in response to the Amendment filed on July 17, 2008. The Amendment added new Claims 8 and 9. Therefore, the currently pending claims considered below are Claims 1-9.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

3. **Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1-4 and 6-9 are rejected under 35 U.S.C. 101 as drawn to a non-statutory subject matter. The claims (or at least independent claims 1 and 9) are related to mental processes, which is not patentable. Indeed, the claims (e.g. claim 1) recite a (mental) process, which is not tied to another statutory class or does not change or switch statutory class (such as a particular apparatus) or does not transform the underlying subject matter (such as an article or materials) to a different state or thing. See MPEP §2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category.*

Claim 5 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, in independent claim 5, the preamble of the claim recites a system, indicating structure, means plus function or Hardware, whereas the body of the

Art Unit: 3688

claim recites data or software per se, which is not statutory. Further, a transaction system component, a backend processing system component, and a database, as defined in the specification, represent software, not means or Hardware. This renders the claims confusing under 35 U.S.C. 101.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1–8 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohagan et al (US 2004/0243468).

The Examiner has verified that the reference's parent application (09/836,213), filed on April 17, 2001, contains adequate support for the below cited features.

Claim 1: Cohagan discloses a method for a loyalty points program, comprising:

a. creating a cardholder profile by receiving cardholder profile information including at least one third-party authorization (i.e. aggregate account holder) allowing the third party to access the account including the option of a global assignment (page 4, paragraph 0039 and page 8, paragraphs 0059-0061);

Art Unit: 3688

- b. allowing the third party to request a transaction with loyalty points according to the stored authorization (page 4, paragraph 0039 and page 8, paragraphs 0059-0061); and
- c. processing/fulfilling the transaction request (page 17, paragraph 0121).

Cohagan discloses that the primary member can enroll one or more supplemental members whose earned reward points are stored in the aggregate consumer account. In one embodiment, the “primary member may designate a particular supplemental member(s) as eligible to redeem any or all of the reward points in the aggregate consumer account and the primary or any other participant may limit the redemption to a specific geographic area”. In another embodiment, “a first supplemental member may designate a second supplemental member as eligible to redeem in a specific geographic area any or all of the reward points earned by the first supplemental member in a specific geographic area.” Thus, Cohagan discloses that the access assignment for the supplemental members may be global, i.e. a supplemental member may at least be able to earn points, redeem points (their own and/or from others), and set additional authorizations for other supplemental members, the same as the primary member.

Claim 2: Cohagan discloses a method as in Claim 1 above, and further discloses the authorization is one of a global assignment, a functional assignment, or a transactional assignment (page 4, paragraph 0039 and page 8, paragraphs 0059-0061).

Claim 3: Cohagan discloses a method as in Claim 1 above, and further discloses comparing the transaction request to the authorization access (page 9, paragraph 0068 and page 15, paragraph 0102).

Claim 4: Cohagan discloses a method as in Claim 1 above, and further discloses receiving a request to change the authorization data for one or more third party participants and updating the authorization access for the participant (page 12, paragraph 0084). The Examiner notes that the disclosure that the primary member can request and set the access authorization for a supplemental member is changing the authorization data for that supplemental member from being not authorized to being authorized in the primary cardholder's account; thus, meeting the claimed feature. Furthermore, while not explicitly claimed, it is inherent or at least would have been obvious to one having ordinary skill at the time the invention was made to allow the primary member to change preexisting supplemental members' authorization data whenever the need arises, such as upon the death or divorce of a spouse, when an employee is no longer an employee, etc.

Claim 5: Cohagan discloses a system for a loyalty points program, comprising:

- a. a transaction system component for managing loyalty point information (Figure 5);
- b. a backend processing system component for receiving third-party authorizations, verifying the third party connection to the primary account, and providing for updates to the authorizations (Figure 5, paragraph 98); and
- c. a database for storing loyalty point information (Figure 5).

Claim 6: Cohagan discloses a method for a loyalty points program, comprising:

a. creating a profile for an account belonging to a cardholder (page 4, paragraph 0039 and page 8, paragraphs 0059-0061); and

b. specifying an authorization access to one or more third party participants allowing the third party to access the account including the option of a global assignment (page 4, paragraph 0039 and page 8, paragraphs 0059-0061).

Claim 7: Cohagan discloses a method as in Claim 6 above, and further discloses the authorization is one of a global assignment, a functional assignment, or a transactional assignment (page 4, paragraph 0039 and page 8, paragraphs 0059-0061).

Claim 8: Cohagan discloses a method as in Claim 1 above, and further discloses verifying that each third-party participant to be given an authorization has sufficient connection to the account prior to granting authorization. (Figure 5, paragraph 98, authentication and/or validation of the identity and status of participants, including any of the other system components, may be performed by the authentication module, which may have access to the records residing in the storage device, this checks whether the third-party participant has authorization to perform certain tasks)

### **Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in*

*which the invention was made.*

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohagan et al (US 2004/0243468) in view of Official Notice.

Claim 9: Cohagan discloses a method for a loyalty points program, comprising:

- a. creating a cardholder profile by receiving cardholder profile information including at least one third-party authorization (i.e. aggregate account holder) allowing the third party to access the account (page 4, paragraph 0039 and page 8, paragraphs 0059-0061);
- b. allowing the third party to request a transaction with loyalty points according to the stored authorization (page 4, paragraph 0039 and page 8, paragraphs 0059-0061); and
- c. processing/fulfilling the transaction request (page 17, paragraph 0121).

Cohagan discloses that the primary member can enroll one or more supplemental members whose earned reward points are stored in the aggregate consumer account. In one embodiment, the “primary member may designate a particular supplemental member(s) as eligible to redeem any or all of the reward points in the aggregate consumer account and the primary or any other participant may limit the redemption to a specific geographic area”. In another embodiment, “a first supplemental member may designate a second supplemental member as eligible to redeem in a specific geographic area any or all of the reward points earned by the first supplemental member in a specific geographic area.”

Cohagan does not specifically disclose wherein the authorization access includes authorization to earn loyalty points, redeem loyalty points, buy back loyalty points, and reinstate loyalty points.

However, Official Notice is taken that being authorized to earn loyalty points, redeem loyalty points, buy back loyalty points, and reinstate loyalty points have been well known activities performed by a primary cardholder. A primary cardholder can give partial or complete authorization rights to a supplemental cardholder, such as a spouse or business partner. Credit card and email accounts are examples of accounts with a primary cardholder, that can give authorization rights to other people.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Cohagan with the commonly recognized practice of authorization to earn, redeem, buy back, and reinstate loyalty points (Official Notice) thereby allowing a spouse or business partner use of the incentive account. The rationale is so that the supplemental cardholder can act in the primary cardholder's absence, such as when the primary cardholder is on vacation or at work.

#### ***Response to Arguments***

8. Applicant's arguments filed July 17, 2008 have been fully considered but they are not persuasive.

a. The Applicant argues that Cohagan does not disclose "an authorization access capable of being a global assignment" and that "there is no suggestion of being able to authorize a third-party participant to access and use any function or transaction available for the loyalty points, as

Art Unit: 3688

can be provided by the global assignment feature of the Applicant's invention" (pages 6-7). This was discussed in the previous rejection, Response to Arguments, section 4a.

Cohagan does disclose that the supplemental member can be authorized to earn points, redeem points he earned, redeem points others have earned, set authorization levels for other supplemental members, etc. Thus, the supplemental member can be provided with "global" assignment. Of course, it would be prudent to place some limitations of the global assignment, such as not allowing the supplemental member to delete the primary member. However, even this feature could be allowed since a supplemental member that was authorized to do everything the primary member could do would essentially be a co-owner, and co-owner of accounts (such as husband and wife checking accounts) are well known within the industry.

b. The Applicant also argues that Cohagan does not disclose that the primary member can change the assignment for a cardholder and that such a change would be used to update the account. This was discussed in the previous rejection, Response to Arguments, section 4b.

Cohagan discloses that the primary member can authorize one or more supplemental members and that this authorization is then entered into the account reads on the claimed feature, i.e. the assignment of the supplemental member has been changed by the primary member from not authorized to authorized, and the account has been changed to reflect the new assignment. As further discussed above, even if the claim were amended so that the change made by the primary member was to a pre-existing supplemental member's assignment, it would have been inherent or at least obvious to do so in order to maintain currency of the account. Examples of when such changes would need to be done are upon the divorce or death of a spouse, the promotion of an employee, the firing or retirement of an employee, etc. If the supplemental

member is no longer employed by the primary member (or is dead), or if the supplemental member has been promoted (e.g. to a management position) or has reached a certain age (e.g. a child has turned 18 years of age), it would have been obvious to update the assignment database to reflect such as change in access authorization.

c. Applicant argues that Cohagan does not disclose authorizing identical access to that of the primary cardholder. Cohagan discloses that the primary member may permit association of any number of supplemental members with the account and that "both primary and supplemental members may earn and redeem reward points which are posted to the aggregate consumer account" (pages 4-5, paragraph 0039). Thus, the supplemental members are authorized "identical access to that of the primary cardholder" as in the proposed amendment to the independent claims. The cited section of the parent patent to Voltmer also discusses that the supplemental members may also earn rewards in addition to the primary member. The Examiner believes this provides support for the above argument in reference to the Cohagan disclosure. A primary cardholder can give partial or **complete** authorization rights to a supplemental cardholder, such as a spouse or business partner. When complete authorization rights are given to a supplemental cardholder, "this is identical access to that of the primary cardholder."

d. Applicant argues that Figure 5 does not show "verifying the connection between a third party participant having a connection to the primary cardholder's account." Cohagan discloses "authentication and/or validation of the identity and status of participants, including any of the other system components, may be performed by the authentication module, which may have access to the records residing in the storage device." (Figure 5, paragraph 98)

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Berman whose telephone number is (571) 270-3603. The examiner can normally be reached on Monday through Thursday 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on (571)272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian Berman/  
Examiner, Art Unit 3688  
9/29/2008

/James W Myhre/  
Supervisory Patent Examiner, Art Unit 3688